

REMARKS

Claims 1-44 remain pending in the present application. Claim 29 is amended herein to fix a clerical claim numbering error. No new matter has been added.

Improper Final Office Action

According to **MPEP 706.07**:

“In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and **also should include a rebuttal of any arguments raised in the applicant’s reply.**” (Emphasis Added)

Applicants respectfully submit that the present Office Action has not provided a rebuttal of **each** of Applicants previously raised arguments. Specifically, Applicants point out that the “Response to Arguments” section at page 2 rebuts only a limited selection of the Applicants non-obviousness arguments. Specifically, it appears as though the Office Action has only responded to two of the Applicants arguments.

However, the Response to Arguments has failed to address the other arguments provided by the Applicants. Specifically, **argument II** under the previous response to 35 USC 103 for Claims 16-28 and 29-44; and **argument I** for Claim 6. In absence of comment from the Office, Applicants are left to conclude that the Office agrees with these unaddressed arguments.

Moreover, based on the lack of a complete response, Applicants respectfully submit that the final rejection is improper and request the finality of the Office Action be removed. Further, if the Office disagrees with any of the non-addressed arguments for allow ability of Applicants' claims, then Applicants respectfully request the Office to address these unaddressed arguments in the next non-final office action after the finality is reversed on the present office action such that the Applicants are able to readily judge the advisability of an appeal.

Claim Rejections - 35 U.S.C. §102

The present office action states that Claims 1-5, 7-15 and 29-30 are rejected under 35 U.S.C. § 102(e) as being anticipated by Raley et al. (2002/0108050).

Applicants have reviewed the cited reference and respectfully submit that the embodiments of the present invention as recited in Claims 1-5, 7-15 and 29-30 are not anticipated by Raley et al. for the following reasons.

I. With respect to Claims 1-5 and 7-15, as stated by the Federal Circuit of Appeals in *In re Oetiker*:

[T]he examiner cannot sit mum, leaving the applicant to shoot arrows in the dark hoping to somehow hit a secret objection harbored by the examiner. The “prima facie” case notion, the exact origin of which appears obscure..., seemingly was intended to leave no doubt among the examiners that they must state clearly and specifically any objections (the prima facie case) to patentability, and give the applicant fair opportunity to meet those objections with evidence and argument. To that extent the concept serves to level the playing field and reduces the likelihood of administrative arbitrariness. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1447 (Fed. Cir. 1992)

Applicants respectfully submit that the rejection of Claims 1-5 and 7-15 as provided in the present Office Action does not clearly and specifically provide any objections to patentability, thereby denying the Applicants fair opportunity to meet the objections with evidence and argument.

Instead, the Office Action appears to be a copy of the Applicants Claims with paragraph numbers inserted therein.

As such, Applicants respectfully submit that a prima facie case for anticipate under 35 U.S.C. § 102(e) has not been made and as such Claims 1-5 and 7-15 are in condition for allowance.

II. Applicants respectfully state that independent Claim 1 includes the feature “A method for selectively controlling access to media disposed on a media storage device, said method comprising:

installing a compliance mechanism on a computer system, said compliance mechanism communicatively coupled with said computer system when installed thereon, said compliance mechanism for enforcing compliance with a usage restriction applicable to said media;

obtaining control of a data pathway operable on said computer system;
accessing data disposed on said media storage device to determine said usage restriction; and

selectively preventing said computer system from digitally accessing said media via said data pathway **while enabling** presentation of the media.” (Emphasis added)

According to the Federal Circuit, “[a]nticipation requires the disclosure in a single prior art reference of each claim under consideration” (W.L. Gore & Assocs. v. Garlock Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Moreover, in order to establish anticipation under 35 U.S.C. § 102 the cited art must not only disclose all elements of the claim, but must also disclose those elements “arranged as in the claim.” Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548 (Fed. Cir. 1983).

Applicants respectfully disagree that Raley et al. anticipates the claimed features and discloses all the elements arranged as in the Claims.

That is, Applicants have reviewed Raley et al. and do not understand Raley et al. to anticipate the features, “**selectively preventing** said computer system from digitally accessing said media via said data pathway **while enabling** presentation of the media.”

In contrast, Applicants respectfully submit that at least paragraphs [0055], [0057], [0105] and [0111] of Raley et al. are understood by Applicants to teach away from the claimed features. For example, [0055] is understood to teach that a web site cannot be accessed. [0057] is understood to teach access being prohibited. [0105] is understood to teach that directories are filtered in order to provide a high level of confidence that content stored on the distributor server as a file cannot be delivered to an unauthorized user no matter what URL is used to reach the file stored on the server. Similarly, [0111] is understood to teach that access to content will be denied.

For this reason, Applicants respectfully submit that since Raley et al. does not disclose all of the Claimed features, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate Claim 1 under 35 U.S.C. § 102(e).

III. Moreover, in the present Office Action response to arguments section, the Office Action states, “Examiner would point out that, Raley (US 2002/0108050 A1) teaches a digital rights management system, including a system for selectively preventing a computer system from digitally accessing a media via a data pathway while enabling presentation of the media (i.e., while media is rendered on a browser, system can be preventing from accessing the media (requests are intercepted and validated), for different types of requests, paragraphs 0059-0062).”

However, Applicants note that in the sections cited by the Office Action, the shortcomings of Raley, as provided in the arguments of Section II, have already been assumed to have been overcome by Raley. For example, at paragraph [0060] Raley states, “More specifically, when connection module 236 receives a request from the rendering engine of browser 232, connection module 236 validates that the rendering engine is protected by VI module 234, i.e. UI module 234 is attached, and that the rendering engine has not been tampered with or otherwise compromised. **If so**, connection module 236 permits connection to rights management module 224 of server 220 and negotiates permission to retrieve the original start Web page on server 220 and the set of rights for the user for the Web page. Rights management module 224 then

initiates a connection between server software 226 of server 220 and connection module 236 of client 230. The connection can be established using any protocol, such as HTTP or HTTPS or any other standard or proprietary connection protocol.” (Emphasis Added)

Thus, Applicants respectfully note that in the section cited by the Office Action, the evaluation and operation of the UI module has already been performed. However, as Applicants have provided in Section II, and incorporate by reference in their entirety herein, if the UI module is not validated, Riley does not teach or anticipate “**selectively preventing said computer system from digitally accessing said media** via said data pathway **while enabling presentation of the media.**”

As such, Applicants respectfully submit that since Raley et al. does not disclose all of the Claimed features “arranged as in the Claims”, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate Claim 1 under 35 U.S.C. § 102(e).

With respect to Claims 2-5 and 7-15, Applicants respectfully point out that Claims 2-5 and 7-15 are allowable as depending from the allowable Independent Claim 1 and reciting further features thereof.

Claim Rejections - 35 U.S.C. §103(a)

Claims 16-28 and 31-44

The present office action states that Claims 16-28 and 31-44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Searle (WO 01/46952) in view of Raley et al.

I. MPEP 2143.01 states “if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious” (*In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). (emphasis added)

Independent Claim 31 (and similarly Claim 16) includes the features, “selectively restricting said media on said media storage device from being accessed via said digital data pathway while enabling presentation of said media using an analog sound rendering device communicatively coupled with said device drive.” (Emphasis Added)

Applicants understand Raley et al. to teach directly away from the claimed features and respectfully submit that the proposed modification would change the principle of operation of Raley et al.

Specifically, Applicants respectfully submit that at least paragraphs [0055], [0057], [0105] and [0111] of Raley et al. are understood by Applicants to teach away from the claimed features and toward the principle of operation of Raley et al. e.g., **denial of access**. For example, [0055] is understood to teach that a web site cannot be accessed. [0057] is understood to teach access being prohibited. [0105] is understood to teach that directories are filtered in order to provide a high level of confidence that content stored on the distributor server as a file cannot be delivered to an unauthorized user no matter what URL is used to reach the file stored on the server. Similarly, [0111] is understood to teach that access to content will be denied.

For this reason, Applicants respectfully submit that a prima facie case for obviousness under 35 U.S.C. § 103(a) has not been made and that Claims 16 and 31 are in condition for allowance.

With respect to Claims 17-28 and 32-44, Applicants respectfully point out that Claims 17-28 are allowable as depending from the allowable Independent Claim 16 and that Claims 32-44 are allowable as pending from the allowable independent Claim 31, and respectively reciting further features thereof.

Claim 6

The present office action states that Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Raley et al. in view of Searle.

I. According to MPEP 2141(III) (citing KSR Int'l vs. Teleflex, Inc., 127 S. Ct. 1727), “[R]jections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (Emphasis Added)

Applicants respectfully submit that the Rejection has not satisfied a *prima facie* case of obviousness. Instead, the Office Action has relied upon speculation and less than a preponderance of evidence.

Specifically, the rationale argued in the present Office Action for combining Raley et al. and Searle is “in order to enhance usability of the system.” Applicants respectfully contend that the statement “in order to enhance usability of the system” is speculative, unsupported with a preponderance of evidence, and appear to Applicants to be based on improper hindsight.

Further, the Office Action has provided no evidence as to how information from Searle or Raley et al. would have made the invention obvious to a person of ordinary skill in the art. Instead, the Office Action has relied upon an indefinite relational term “enhance usability of the system” without providing any evidence as to how usability is enhanced, what enhancement means, to whom the enhancement would be recognized, what is meant by usability of the system, etc.

As such, Applicants respectfully submit that a *prima facie* case for obviousness under 35 U.S.C. § 103(a) has not been made and that the rejection of Claim 6 is improper and should be withdrawn.

As such, Applicants respectfully submit Claim 6 is in condition for allowance.

CONCLUSION

Based on the arguments presented above, Applicants respectfully assert that Claims 1-44 overcome the rejections of record, and therefore, Applicants respectfully solicit allowance of these Claims. Moreover, based on the lack of response to Applicants previous arguments, in understand with MPEP 706.07, Applicants respectfully request withdrawal of the improper finality of the present Office Action.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

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